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IN THE

# Supreme Court of the United States

OCTOBER TERM 1971

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No. 71-485

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ROBERT GOTTSCHALK, Acting Commissioner of Patents,
*Petitioner,*

v.

GABY R. BENSON and ARTHUR C. TABBOT,
*Respondents.*

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On Petition for Writ of Certiorari to the United States Court of Customs and Patent Appeals

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## MOTION FOR LEAVE TO FILE BRIEF AMICUS CURIAE

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The Business Equipment Manufacturers Association (BEMA) respectfully moves for leave to file the attached Brief Amicus Curiae in the above-entitled case. Petitioner has consented to the filing of this

brief. The consent of respondents was requested but refused.

BEMA is the trade association which has represented the business equipment industry for the past 54 years. The sixty-five (65) companies comprising the current BEMA membership include the nation's leading manufacturers of computers and computer-related equipment. While product lines of member companies vary widely, the following list is illustrative: electronic computers, computer software, including programs, computer input and output devices, computer storage devices, support services, data transmission equipment, optical character readers, addressing machines, accounting machines, bookkeeping machines and office copying machines. The extent to which such equipment can be effectively utilized depends in great measure on the applications and systems programs developed by computer programmers to control the operations of these machines. BEMA is also the approved sponsor under the American National Standards Institute (formerly the American Standards Association) for the establishment of domestic and international standards related to information processing, computers and office machines.

One of BEMA's three semi-autonomous product area groups—the Data Processing Group (DPG)—is especially concerned with the outcome of the issues presented in this case. The members of DPG have consistently been forerunners in achieving major developments, in both the concept and application, of computer programming and data processing, and have contributed greatly to the present significant status and role of the computer in modern society. These members maintain extensive programs devoted to

applied research and systems development in all phases of computer use and data and information processing.

It is readily apparent that the subject matter of the present case is of vital concern to the BEMA membership as well as to non-BEMA members in the computer and data processing field and, more importantly, to the government and public. The final outcome of the issues squarely presented in this case will have a significant influence upon both the immediate and the future planning of DPG members with respect to computer program development and research. Thus, the outcome of the present case will inevitably affect the future growth and development of the data processing industry in the United States and will have a corresponding or greater impact on the vast segments of our society which use and receive the benefits of technological advances in the industry.

The attached Brief Amicus Curiae presents three important aspects of this case which were not fully treated in the Solicitor's petition: first, the question of probable impediments to the future technological development of the data processing industry which would result from the decision of the United States Court of Customs and Patent Appeals; second, the critical necessity for a definitive resolution of this issue now in order to avoid (a) the inevitable difficulties and uncertainties which will flow from the lower court's decision, (b) the expected flood of complex patent infringement suits which will surely follow, and (c) the resultant damage to the technological promotion of the art and the public which it services; third, the substantial questions of constitutional and statutory construction raised by the lower court decision.

Accordingly, BEMA respectfully requests that this Court grant leave to file the attached Brief Amicus Curiae.

Respectfully submitted,

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November 11, 1971

IN THE

# Supreme Court of the United States

OCTOBER TERM 1971

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No. 71-485

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ROBERT GOTTSCHALK, Acting Commissioner of Patents,
*Petitioner,*

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On Petition for Writ of Certiorari to the United States Court of Customs and Patent Appeals

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## BRIEF AMICUS CURIAE FOR THE BUSINESS EQUIPMENT MANUFACTURERS ASSOCIATION

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### I

### QUESTION PRESENTED

Whether a computer program constitutes patentable subject matter under the patent clause of the Constitution and applicable provisions of the Patent Code.

## II

## INTEREST OF THE BUSINESS EQUIPMENT MANUFACTURERS ASSOCIATION

The Business Equipment Manufacturers Association (BEMA) is the trade association which represents the major manufacturers of computers and related equipment[1] as well as the office machines and office equipment manufacturing industries. BEMA's interest in this case is that the lower court's decision will inevitably bring about a chaotic situation to the detriment of the producers and users of computers, and to the public which they serve. Accordingly, whether or not the decision of the lower court is reversed or upheld is, in BEMA's view, a secondary consideration to the importance of having the issue definitively decided now by this Court.

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[1] The Data Processing Group of BEMA consists of the following companies:

Addressograph Multigraph Corporation
Ampex Corporation
Burroughs Corporation
Computer Machinery Corporation
General Electric Company
GTE Information Systems, Inc.
Honeywell, Inc.
IBM Corporation
Moore Business Forms, Inc.
Mosler
The National Cash Register Company
Olivetti Corporation of America
Pitney-Bowes, Inc.
RCA Corporation
Control Data Corporation
Data Products Corporation
Data Recall Corporation
Digitronics Corporation
The Singer Company
Sperry Rand Corporation
The Standard Register Company
TRW Data Systems, Inc.
Tally Corporation
UARCO, Inc.
Wang Laboratories, Inc.
Xerox Corporation

## III

## REASONS FOR GRANTING THE WRIT

**A. Unless the question of patentability of computer programs is finally resolved now by this Court, the uncertainty resulting from the lower court's decision will impede future technological developments to the overall detriment of the public**

By requiring the Patent Office to issue a whole new class of patents on computer programs, the court below has brought about a basic structural change in the computer industry which will impede development of future technology to the detriment of the public. Many thousands of arguably new computer programs are developed each year, principally by computer users, and a large proportion of these will now be patented. However, because of substantial disagreement as to the validity and ultimate scope of such patents, years of infringement litigation can be expected.[2] In this atmosphere, more restrictive practices of handling programming information will develop. Such practices will not be in the public interest, and will ultimately impede the advance of the overall "state of the art".

In addition, substantial practical impediments will be imposed on users of computers as a result of this decision. Computers are now being used virtually in all segments of our society and even under presently known technology the next decade will see a whole spectrum of new uses and applications touching on every aspect of human development. However, as a

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[2] BEMA estimates that as a direct result of this decision literally thousands of patents of dubious validity will be issued, each one subject to the financial burdens and stultifying effect of threatened patent litigation.

result of the instant decision all users of computers will have to assume a major responsibility for determining questions of patent infringement growing out of computer programs they intend to use. They will be burdened with the need to spend substantial time and money in right-to-use searches every time a different algorithm is to be programmed on an existing computer. Adversely held patents based on computer programs will be a constant threat to the right of computer users to make full use of computers owned or leased by them.

Furthermore, it is expected that in the next few years, computers will be widely used on a shared-time basis and the existence of patent monopolies on computer programs may seriously impede effective development and utilization of these multi-user systems. Often the proprietor of the computer in such systems does not know what programs the user is using, and the user will frequently not be fully acquainted with all of the details concerning the structure and make-up of the computer. It will be substantially impossible for either of them to make an adequate right-to-use search and determine whether existing computer program patents could be infringed.

It is also noteworthy that the tremendous development in computer programs, also known as software, since the early 1950's has essentially taken place in a legal atmosphere conducive to the free exchange of ideas and information. For example, in 1966 when the Department of Justice examined the computer programming field it found:

> "Growth in the software portion of the computer industry has been facilitated by a remarkably free and easy exchange of ideas, concepts, and pro-

grams. One of the notable features of the programming industry, indeed, has been the widespread establishment, sponsorship, and universal acceptance of joint user groups to facilitate the exchange of programs and algorithms. As a result, for the past twenty years, *almost all basic ideas in computer programming have been available openly to all computer users.*" (Emphasis added).[3]

In this free setting, computer technology was able to develop within the decade to a point of sophistication making possible man's voyage to the moon.

Also, in terms of economic significance, the commercial computer industry has been able to grow, without patent protection for computer programs, from virtually nothing in the early 1950's to the point

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[3] Letter dated October 21, 1966, from Donald F. Turner, Assistant Attorney General, Antitrust Division, to Edward J. Brenner, Commissioner of Patents. This letter further states that as a matter of public policy patents should not be granted:

"One of the major policy arguments advanced for extension of patent protection to computer programs is a supposed need to encourage individuals and companies to invest in programming development. But it is difficult to conceive how the field of programming could have grown faster, or that its past growth has been hampered in any meaningful fashion by a lack of investment funds. If anything, the current free interchange of programs has led to an extraordinarily efficient use of scarce programming talent and has kept needless duplication of existing programs and techniques to a minimum. Furthermore, many small software companies have achieved financial and technical success by producing more efficient versions of widely used manufacturer-developed programs. These more efficient versions of operating programs benefit other software producers, computer manufacturers, computer users, and the general public. In the light of past experience, any step which could upset the vital interchange of programming material should be approached with the utmost caution."

where today there are in use over 140,000 computer systems made by American based companies, with a cumulative value in excess of $43 billion.[4] This growth rate will accelerate, and it has been reliably estimated that by 1975 there will be in use over 350,000 computer systems with a value in excess of $82 billion.[5] Moreover, computer users are already spending as much on programming today as they are on computer hardware. In a matter of less than five years they will be spending twice as much on the programs as on the machines, and the so-called software segment of the computer industry will more than double in size.[6]

The future applications for computers are virtually unlimited and some widely accepted predictions for computer uses in the next 10 to 25 years are:

**Health and Medicine:**

> Computers will revolutionize health care and will serve as communication and information links among various hospital centers and individual doctors' offices or clinics to improve diagnosis, patient care and medical data. Computers will also make possible many breakthroughs in medical research, including a cure for cancer.

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[4] EDP Industry Report, March 12, 1971, Vol. 6, No. 9, at p. 7. These figures are for worldwide use of computers made by American companies. In the United States alone, the cumulative value of computer systems in use in 1971 was approximately $27 billion and by 1975 this figure will exceed $44 billion.

[5] *Id.* at p. 12. It is also reported that in 1971 total revenue for American-based companies from computers and related activities will be $13.7 billion and that in 1975 total revenue will be $25.6 billion.

[6] "Towards the Computer Utility: Evolution or Revolution", *Datamation*, October 1969, p. 125.

**Education:**

In the field of education, computer aided training and instruction will become commonplace, and for the first time high quality education will be available to all children on an equal basis, including those in ghettoes and remote rural areas. Also, computers will be largely responsible for making it practical for everyone to have the advantages of higher learning.

**Science:**

Computers will make possible further advances in science, such as exploration of space, including interplanetary travel.

**Information Processing:**

High speed computer systems, on a global basis, will transmit data and messages instantly between any two points on earth or colonized space. Government officials, businessmen, scientists, students, even housewives and children will be able to converse with these computers and obtain information they need as easily as they now talk by telephone.

**Government:**

Computers will present unique opportunities for government to become more efficient and effective. For example, there are tremendous potentials for computers to assist in relieving the nation's crowded court dockets, to collect and analyze legal documents and precedents, and to achieve better overall administration of the rapidly increasing work load of the police and law enforcement agencies.

**Economics:**

Computers will soon handle most credit and monetary transactions, thereby substantially limiting the need for cash and checks.

**Written Communications:**

The use of mail service will be significantly affected by computer oriented techniques and alternative means of communicating data. Frequently encountered delay in communicating important written material will be largely eliminated and will be replaced by point-to-point transmission of data and information.

**Transportation:**

More efficient transportation systems will be made possible, including computerized control of automobiles and rapid transit systems.

**Home and Office:**

Home and office use of centralized computers serving the needs of many users will become common in a few years, and these computers will assist in performing many functions such as climate and lighting control, food procurement, budgeting, medical care, etc.

The few examples cited above show that computers have a potential substantially to upgrade the quality of life for every American. To a significant extent, though, whether the future potential of computers is fully realized depends on the legal framework within which the computer industry continues to develop.

The lower court in this case by giving legal sanction to patent monopolies over computer programs has substantially altered the legal framework within which the industry has grown in the last 25 years. The court has consciously departed from the heretofore prevailing system of encouraging the free exchange of ideas concerning technological developments in this important area and has submitted a system which will necessarily restrict the free dissemination of ideas and information

on developments in computer programming. Before such a restrictive system is broadly applied to a technology affecting so many parts of our society, this Court should finally determine the question of whether patents may properly be issued for computer programs.

In view of the above, it is submitted that since the practical result of the instant decision will be to bring about an era of uncertainty and confusion in the data processing industry and specifically in the development of computer programs, the question presented here should be determined now with finality.

**B. The question presented by the decision below should be reviewed now**

The Court of Customs and Patent Appeals has already held at least seven computer program applications patentable—i.e., in the decision below and in the decisions in the *Prater II*, *Musgrave*, *Mahony*, *Foster*, *Bernhart*, and *McIlroy* cases.[7]

Because of these decisions, the Patent Office is no longer following its prior policy of rejecting applications for patents on computer programs because they are based upon mental steps which are not a patentable "process" under §§ 100(b) and 101 of the Patent Code, Title 35, U.S.C.[8] Accordingly, the basic objection

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[7] *In re Prater*, 415 F.2d 1378 (C.C.P.A. 1968), *mod. on reh.*, 415 F.2d 1393 (C.C.P.A. 1969); *In re Musgrave*, 431 F.2d 882 (C.C.P.A. 1970); *In re Mahony*, 421 F.2d 742 (C.C.P.A. 1970); *In re Foster*, 438 F.2d 1011 (C.C.P.A. 1971); *In re Bernhart*, 417 F.2d 1395 (C.C.P.A. 1969); *In re McIlroy*, 170 U.S.P.Q. 31 (C.C.P.A. 1971).

[8] See S. Doc. No. 5, 90th Cong., 1st Sess. 21 (1967); Patent Office, Guidelines to Examination of Application for Patents on Computer Programs, 33 Fed. Reg. 15609 (1968); Patent Office, Suspension of Guidelines to Examination of Application for Patents on Computer Programs, 34 Fed. Reg. 15724 (1969).

that computer programs are not patentable subject matter will not be raised again by the Patent Office as a basis for refusing an application, and many thousands of such patents will be issued even though this Court has not finally determined this important issue.

Until the basic question of patentability of computer programs is resolved by this Court, those who create and use programs will be compelled to operate in an atmosphere of distrust and secrecy and even to engage in protracted litigation in infringement suits. It can be anticipated that rights under the thousands of computer program patents which must be issued by the Patent Office as a result of this decision will be licensed and users will have the option of either accepting the licensed terms or contesting the validity of the underlying claims upon which the patents are based in infringement litigation brought by the holder of the patent. In such litigation, the user's most basic defense will be that such programs are not patentable subject matter under the Constitution and the Patent Code. The decision of the Court of Customs and Patent Appeals in this case will not be binding precedent on the various federal district courts and circuit courts of appeals which must decide these infringement suits, and in view of the substantial difference of opinion on this question, it is reasonable to expect that conflicting decisions will occur.

To defer review of the issue of patentability of computer programs *vel non* until patent infringement litigation eventuates and matures to the point of reaching this Court will simply multiply the opportunities for endless litigation. Not only *all* of the computer program patents so far issued, but *each* claim of each, is *statutorily presumed* valid (35 U.S.C. § 282). Even

should one or more claims of *one* of these many patents be held invalid by this Court after time-consuming infringement litigation and appeals, the statutory presumption of validity attaching to each claim of each of the remaining patents will *still* remain. For an example of the way in which patents on the same general subject, *all* presumptively valid, proliferate and result in endless litigation, see the discussion of patents in the shoe machinery industry in *Williams Mfg. Co.* v. *United Shoe Machinery Corp.*, 316 U.S. 364, 371 (1942), Mr. Justice Black dissenting, especially at 372-3, 381-2 and 392-4.

It is thus apparent that since the issue of patentability of computer programs is now ripe for final resolution by this Court, it is imperative for the orderly development of future technology in this important area that there be a final resolution now of this issue.

**C. The decision of the lower court raises substantial questions of constitutional and statutory interpretation that should be finally resolved by this Court**

There is a serious question whether the claim asserted in this case is one of the "discoveries" contemplated by the patent clause of the Constitution, which provides:

> "The Congress shall have power . . . to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." [Art. I, § 8, cl. 8]

The focus of the patent clause (and the statutes implementing that clause) is on "progress" and Congress is granted only a "qualified authority . . . *limited to the promotion* of advances in [science and] the useful arts." *Graham* v. *John Deere Co.*, 383 U.S.

1, 5 (1966). Because "[t]he patent system must promote . . . progress," *Graham, supra,* "[p]atents cannot be sustained when . . . their effect is to subtract from former resources freely available to skilled artisans," *Great A & P Tea Co. v. Supermarket Equipment Corp.,* 340 U.S. 147, 152 (1950). Among such "resources" as the Solicitor General's petition in this case states, are the "scientific principles, mental processes and abstract intellectual concepts" which "are the basic instruments of scientific and technological development" (Petition, p. 8).[9]

The claims in this case have been described in the following relatively simple language by the Patent Office Examiner who initially reviewed them:

> "The method claimed is merely a program which is a set of instructions to control the operation of a computer. The instructions are not a statutory process such as a method of manufacturing an article, but a logical list of mental steps which can be applied to a computer to allow it to imitate the mental steps" (R. 18).[10]

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[9] It is also apparent that any efforts to sanction the patenting of computer programs inherently raises serious constitutional questions under the First, Ninth and Tenth Amendments to the Constitution. The patent clause in Article I, Sec. 8, of the Constitution must be construed in light of the other constitutionally assured rights, and freedom of mind or thought may not be abridged by the patent laws.

[10] The significance of the instant decision is that it makes it possible for someone to obtain a patent on claims covering a method or algorithm for solving problems, regardless of the nature of the apparatus used to accomplish this end. Indeed, the Court of Customs and Patent Appeals noted that the method encompassed by the claim in this case could theoretically be implemented by any kind of recording medium, including "pencil and paper and even, when possible, red and blue poker chips and a surface to hold them or slots to put them in so that 'o's and l's' can be represented."

Because of the nature of the claims, the Patent Office Board of Appeals in its opinion found, as a fact, that they could not be patentable "processes" under the relevant statutory provisions:

> ". . . that claim 13 is so broad as to read on the mental activity alone of a mathematician while carrying out a set of rules or, more precisely, an algorithm, that expresses a relation of one arbitrary system of symbolizing an abstract number to another system for symbolizing the same abstract number. There is no physical act on a physical thing suggested by this claim. . . .
>
> "The fact that a mathematician may, as an aid to his memory, routinely elect to record on a suitable medium the symbols incident to his following the procedure specified by an algorithm, such as pencil and paper or other conventional computational apparatus, does not change the basic character of the process from its being an intangible, abstract line of reasoning." (Solicitor General's Pet. App. D, p. 39).

The Board also found:

> "Thus it is to be seen that denying to the mathematician, as the appealed claims would do, access to the usual tools of his profession, such as pencil and paper or a programmable computer, is to deny him an opportunity to understand appellants' mathematical algorithm. Such denial is a restriction on mental process and is tantamount to granting a patent thereon. It is not seen how such restriction on mental processes could promote science or the useful arts." (Solicitor General's Pet. App. D, p. 40).

And further found:

> ". . . a method, as here, which deals with manipulations of the meanings or representations made by

signals is a method of manipulating mental concepts and not of physical things." (Solicitor General's Pet. App. D, p. 41).

In view of these findings by the Patent Office Examiner and Board of Appeals, it is apparent that there is substantial doubt that the claims involved here are a patentable "process." [11] Indeed, this Court, in the landmark decision of *Cochrane* v. *Deener*, 94 U.S. 780 (1877), observed that basic scientific truths and mental abstractions cannot be patentable as a "process," [12] and this principle has become settled law. See, e.g. *Tilghman* v. *Proctor*, 102 U.S. 279 (1881); *The Telephone Cases*, 126 U.S. 1 (1887); *New Process Fermentation Co.* v. *Maus*, 122 U.S. 413 (1887); *Expanded Metal Co.* v. *Bradford*, 214 U.S. 366 (1909); *DeForest Radio Co.* v. *General Electric Co.*, 283 U.S. 664 (1931); *Mackay Radio and Tel. Co.* v. *R.C.A.*, 306 U.S. 86 (1939); and

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[11] Normally, fact findings by the administrative tribunal are conclusive on the CCPA, an appellate tribunal, unless demonstrated to be clearly erroneous. *In re Kunzmann*, 326 F.2d 424 (CCPA 1964); *Application of Wintzel et al.*, 39 F.2d 669 (CCPA 1930); *Zenith Radio Corp.* v. *Ladd*, 310 F.2d 859, 862 (D.C. Cir. 1962); and *Lyman* v. *Ladd*, 347 F.2d 482 (D.C. Cir. 1965).

[12] *Cochrane* v. *Deener* defines a patentable process as follows (94 U.S. at 788):

> • • • A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing. If new and useful, it is just as patentable as is a piece of machinery. In the language of the patent law, it is an art. The machinery pointed out as suitable to perform the process may or may not be new or patentable; whilst the process itself may be altogether new, and produce an entirely new result. The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence.

*Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127 (1948).[13]

Further, the decision by the lower Court in this case clearly illustrates its continuing and substantial dispute with the Patent Office over whether the standards of patentability set forth in *Cochrane, supra*, prevent computer programs from being patented.[14] Subsequent infringement litigation over patents of this nature which the Patent Office must now issue will almost inevitably result in a similar dispute between the CCPA and some federal district courts and circuit courts of appeal. The net result will be chaos and confusion in the computer industry and the public will be irrevocably harmed.

This Court perceived the serious nature of such a conflict in *Brenner v. Manson*, 383 U.S. 519 (1966), and wisely granted certiorari to resolve the "running dispute" between the Patent Office and the CCPA over the definition of "utility" in chemical process claims. The Court noted that in addition to the conflict between the CCPA and the Patent Office, an arguable conflict existed between the CCPA and the Court of Appeals for the District of Columbia.

In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), this Court also recognized that a definitive decision was necessary to prevent an unnecessary waste of judicial and administrative resources where a substantial conflict had developed between the Patent Office and the CCPA.

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[13] Also, cf. *LeRoy v. Tatham*, 55 U.S. 156 (1852); *O'Reilly v. Morse*, 56 U.S. 62 (1853).

[14] See cases cited in n. 6, p. 9, *supra*, wherein the CCPA has reversed Patent Office rejection of process claims on the ground that they are purely "mental steps."

As the Court noted in that case: "To await litigation is—for all practical purposes—to debilitate the patent system."

Accordingly, in view of the substantial constitutional and statutory questions presented here and further in view of the significance of the subject matter of this case, it is clear that this Court should finally resolve this controversy now.

## CONCLUSION

For the foregoing reasons, we respectfully submit that the Solicitor General's petition for a writ of certiorari should be granted.

Respectfully submitted,

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